

Application No. 10/673,050
Reply to Office Action of March 22, 2006

Amendments to the Drawings

The attached sheet of drawings includes changes to Fig. 2. This sheet replaces the original sheet containing Fig. 2. In Figure 2, omitted workstations 206 have been added.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

In an Office Action dated March 22, 2006, claims 8-12 were objected to; claims 1-12 were rejected under § 112, ¶ 1; claims 1-12 were rejected under § 112, ¶ 2; claims 1-12 were rejected under § 101; and claims 1-12 were rejected under § 102. Applicants traverse all of the objections and rejections.

Drawing Amendment

A revised Figure 2 is provided. While Applicants believe that Figure 2 was originally provided correctly, as the published version has portions missing, apparently because the printer printed the drawing in the wrong orientation, a replacement Figure 2 is provided to correct the error.

Claim Objections

Claims 8-12 were objected to as being of improper dependent form. Applicants respectfully traverse the objection. Claim 8 is an independent claim, not a dependent claim, and is of proper form. Claim 5 defines a singular tool according to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to assess a litigation. Thus claim 8 utilizes the various decisions provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation. As an analogy, if claim 5 were to claim a wrench, then claim 8 would include a plurality of the wrenches of claim 5. The claim format, while unusual, is proper and Applicants submit that the objection should be withdrawn.

§ 112, ¶ 1 Rejections

The first rejection relates to claim 1 and the combination of discovery related information and form discovery materials to produce discovery items. Applicants refer to ¶ 9 of the published application¹ and to ¶¶ 53 and 54. As can be seen ¶ 9 discusses links to existing document and form production tools and ¶ 54 discusses merging the particular discovery

¹ All paragraph numbers references to the specification in this response are to the published application.

questions with other form discovery materials. Thus merging is specifically mentioned as one method of combining. Other techniques will be readily known to one skilled in the art, based on the particular tool or method used to produce the discovery materials, be it a specialized program or a word processor such as Microsoft Word.

The second rejection relates to claim 5 and decisions in litigation. The Office Action has misinterpreted the phrase “decision in litigation” to be the judgment provided by the judge or jury. Many decisions must be made during the course of litigation. One example of a decision in litigation used in the present application is whether to remove a particular case from state court to federal court. See ¶¶ 35 to 37 of the specification and related Figs. 19-22, especially Fig. 21. As a more familiar example, after a Final Office Action an Applicant has a choice of (1) abandoning the application, (2) appealing the rejection, (3) filing an RCE and further arguments or (4) filing an After-Final response. The Applicant must make a decision in the prosecution, which is analogous to decisions which must be in litigation. Applicants submit that the specification is enabling and withdrawal of the rejection is requested.

The third rejection also relates to claim 5 and a purported subjective interpretation. Applicants traverse this rejection. The Office Action is apparently confusing the inputs to the tool used to perform the analysis with the analysis itself. The analysis operates on these subjective values provided by the users. Contrary to the Office Action, the analysis will always produce the same result when the same values are provided. Clearly, the analysis might produce different results where different values are provided, but that is the purpose of the analysis, to operate on the values provided to it. Most equations will produce different results when different values are provided. Contrary to the statements of the Office Action, the users conduct no experimentation, they simply answer the provided questions in the illustrated embodiments. The recommendation element, embodiments of which are described in ¶ 36, then provides the resulting recommendation. Withdrawal of the rejection is requested.

The fourth rejection relates to claims 5-12 and is apparently based on a perception that the numerical score value must be specifically defined. Applicants traverse the rejection. The illustrated embodiments utilize weighted analysis values to form a score, with the score

translated to a recommendation. *See* ¶ 36, particularly at the top of the second column on page 3. The end result of the tool is a recommendation. Any numerical values utilized in the analysis process are internal to the tool itself and are used in the internal calculations and analysis. As such, those numerical values need not necessarily have a specific meaning to a person in the industry. It is sufficient that they have a range and that the range is known so that scores can be converted to recommendations. Further, the actual numerical values would likely vary based on the specific analysis techniques utilized in any event, so again absolute meaning of the specific numeric values is not necessary. Once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then, and is not required to be defined with respect to the outside environments in any event. Applicants submit that the specification is sufficiently enabling when considered by one skilled in the art and withdrawal of the rejection is requested.

The fifth rejection relates to claim 5 and how a recommended decision is made. Applicants vigorously traverse this rejection. Applicants refer to ¶ ¶ 35-37 for an example on how a recommended decision is made. As explained for that embodiment, entry or data values are used in a weighted analysis. The weighting values are combined to form a score, which is translated to a recommendation. Other methods are then mentioned, including correlation and statistical decision tree analysis. This is clearly enabling to one skilled in the art. The withdrawal of the rejection is requested.

The sixth rejection relates to claim 6 on a similar basis as the fifth rejection. Paragraph 36 specifically mentions using prior case results with correlation or statistical decision tree analysis. Withdrawal of the rejection is requested.

The seventh rejection relates to claim 8 and states that how an assessment is provided is not described. Applicants also vigorously traverse this rejection. Applicants first refer to ¶ 30 and Fig. 4. Recommendation 310 is the assessment for the illustrated case. Quoting from ¶ 30: “This is based on the analysis of the collected data and case history review of similar cases and provides a recommendation as to the assessment and procedure for the particular case.” Thus the assessment is the recommendation for the overall litigation, not just a recommendation on one

decision or element of the litigation. Paragraph 31 describes an overview of the various steps and states: “Each of these are task and data gathering steps to help develop recommendations. The actual data gathered is used in a weighted manner to help determine the recommendation.” Proceeding then to ¶ 33, which relates to business/venue analysis, it states: “The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool.” Next proceed to ¶¶ 35 and 36, discussed above in more detail, which provide details on removal analysis and also the general analysis techniques and methods used in the illustrated embodiments of the invention. Paragraphs 38 (responsive pleading task), 41 (claim and evidence), 42 (particular termination), 43 (prior charges), 44 (comparator), 45 (decision to terminate) and 50 (damages) discuss further data used in the weighting analysis. See ¶ 49 which states: “Thus, this is a systematic way to gather all of the proof points necessary for the case, with the proof point data being used in the weighting analysis to help determine overall recommendation for the particular case.” Applicants submit that the specification does describe a technique to provide an assessment or overall recommendation of the case and therefore the rejection is improper.

The eighth and final rejection relates to claims 9-12 and the statistical decision tree. Applicants traverse the rejection. The use of a statistical decision tree is specifically mentioned in ¶ 36. Applicants submit that statistical decision trees and the particulars of their development are well known to those skilled in the art and thus are not required to be explained in detail. A simple search on Google results in thousands of hits, one indicator that the technique is well known. Withdrawal of the rejection is requested.

§ 112, ¶ 2 Rejections

The Office Action rejects claims 1-12 under § 112, ¶ 2 for several reasons. First, the Office Action states it is unclear which statutory class the invention falls into. Applicants submit the present claims are properly classified as apparatus or system claims. The present claims are a combination of graphical user interface elements and related data fields (See claim 1, entry field and view), physical storage (See claim 1, storage), stored information (from discovery materials), and a generally computer-implemented process (discovery production mechanism). Claims 5

and 8 have similar correlations. Each element clearly falls into the apparatus classification, so the whole invention must then also fall into the apparatus classification.

Second, the Office Action requests a definition for “a tool.” Applicants are using normal meaning for the term. For example, tool as a noun is defined as “something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession” in Webster’s Ninth New Collegiate Dictionary. When the specification and claims are reviewed, Applicants submit that their use of the word is consistent with that definition, an ordinary meaning of the word “tool.”

Third, the Office Action requests clarification of the phrase “an entry field” in claim 1. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled “Discovery Generator.” Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the “Discovery Generator” button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described embodiment and is not to limit the meaning of the claim term to that specific example.

Fourth, the Office Action requested identification of an “analyzer.” Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here.

Fifth and finally, the Office Action is confused by the use of “tool” for both claim 5, and claim 8 which incorporates claim 5. Applicants submit that the response related to the claim objections addressed this rejection.

§ 101 Rejection

The Office Action rejected the claims on various § 101 grounds. Applicants respectfully traverse all of them.

The first rejection was based on non-statutory subject matter. Applicants submit this rejection has been addressed above with the § 112, ¶ 2 rejection, where it was clearly illustrated the present claims are properly apparatus claims.

The second rejection is based on a requirement that the invention produce a useful, concrete and tangible result and a confusion about the use of subjective values in the invention. While Applicants believe this has been addressed under the third rejection under § 112, ¶ 1, Applicants again note that the Office Action is confusing input data with the operation of the invention. For a given set of input data, the invention will always produce the same result, a useful, concrete and tangible result, for claim 5 a recommendation and for claim 8 an assessment. Different inputs may well produce different results, but such is generally true.

Applicants submit that the § 101 rejections are improper and should be withdrawn.

§ 102 Rejections

Claims 1-12 were rejected under § 102 over Newell. Applicants traverse the rejections.

With the above-description and explanation of the claims and the inventor, Applicants submit that it is readily apparent that numerous elements of the claims are missing in the Newell reference.

Claim 1

Applicants first note that Newell is not related at all to developing discovery materials. Newell is simply a litigation management system, a hyperlinked database of all of the information and materials in the litigation. It only contains previously developed material. That said, it is clear that Newell does not contain “an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests” nor “a discovery production mechanism to combine stored discovery related information and form discovery materials to produce discovery items for use in the litigation.”

Claim 5

Applicants here note that Newell is not related at all to recommending a decision in litigation, Newell being merely a hyperlinked database of case information. As such, Newell does not disclose any of the claim elements starting at “weighting values associated with each element of selected information.”

Claim 8

Applicants here note that Newell is not related at all to assessing a litigation, Newell being just a hyperlinked database. As such, Newell clearly does not disclose the “plurality of tools according to claim 5, each tool for a decision in the litigation” or “assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment.”

Applicants therefore submit that the § 102 rejections are improper and must be withdrawn.

CONCLUSION

Based on the above remarks Applicants respectfully submit that all of the present claims are allowable. Reconsideration is respectfully requested.

Respectfully submitted,

Dated: June 21, 2006

/Keith Lutsch/
Keith Lutsch, Reg. No. 31,851

WONG, CABELLO, LUTSCH,
RUTHERFORD & BRUCCULERI, L.L.P.
20333 State Highway 249, Suite 600
Houston, TX 77070
832/446-2400
832/446-2424 (facsimile)
wcpatent@counselip.com

Application No. 10/673,050
Reply to Office Action of March 22, 2006

Drawing Amendment Attachments